different meaning to those skilled in the art. This amendment should overcome any question at to which meaning is intended.

The claims have further been rejected under 35 USC § 112. Initially the Examiner objected to the use of the term "adapted" as being indefinite. This is simply using functional language to define structural limitations of an apparatus and is perfectly acceptable. Although this is not recited in means plus function language, Section 112 specifically provides for this, stating: "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof and such claim shall be construed to cover the corresponding structure material or acts described in the specification and equivalence thereof." The CAFC in In re Schreiber 44 USPQ 2d 1429, 1432 specifically stated a patent applicant is free to recite features of an apparatus either structurally or functionally. Accordingly, applicant would request that this rejection under 35 USC § 112 be withdrawn.

Further Examiner has objected to certain claim language under 35 USC § 112. Specifically, the Examiner objected to inserting the limitation "wherein said device does not have means to mix a sample in said cell." Applicant's invention clearly shows a structure which has no mixing apparatus. This application itself then describes the functioning of the cell, indicating that it operates quiescently. One skilled in the art would clearly realize that Applicant's apparatus functions without active mixing and therefore Applicant is entitled to claim the absence of such structure.

More particularly, the disclosure required by § 112 is directed to those skilled in the art. See In re Hayes Microcomputer Products, Inc. Patent Litigation, 982 F.2d 1527, 25

U.S.P.Q.2d 1241 (Fed. Cir. 1992). In order to meet the written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed but "the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed". In re Gosteli, 872 F2d 1008, 1012 (Fed. Ci. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that as of the filing date sought, he or she was in possession of the invention." Vas-Cath v. Mahurkar, 935 F.2d 1555 at 1553-64 (Fed. Cir. 1991). How close the original description must come to comply with the description requirement of § 112 must be determined on a case by case basis. Eiselstein v. Frank, 52 F.3d 1035, 1039 (Fed. Cir. 1995).

For example, in Vas-Cath v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991), the Court of Appeals for the Federal Circuit held that a design patent provided adequate written description for a utility patent. In a design patent the claimed invention is the ornamental appearance of a device. Functional features are not claimed. Whereas in a utility patent, only functional features are claimed. Further, a design patent has no writing, it has only drawings. Therefore drawings per se can provide adequate written description for a subsequent utility patent.

As the Court of Customs and Patent Appeals, now the CAFC, stated in In re Smith and Ubern, 481 F.2d 910, 178 U.S.P.Q. 620 (CCPA 1973) "compliance with the first paragraph of § 112 is adjudged from the perspective of the person skilled in the relevant art. This Court has held that claimed subject matter need not be described in haec verba

in the specification in order for that specification to satisfy the description requirement . . .". When the original specification accomplishes that, regardless of how it accomplishes it, the essential goal of the description requirement is realized. Id. At 614.

The Court in In re Reynolds, 170 U.S.P.Q. 94 (CCPA 1971) was even more explicit. In Reynolds, the applicant added the following phrase to the claims: "means for preventing an abrupt change in the capacitance characteristic of the capacitor at the point where such auxiliary part of said one capacitor plate ceases to be opposite said other capacitor plate." The applicant admitted that there was no express teaching in his specification of structure for preventing abrupt change of capacitance as the auxiliary parts departed from the confronting relationship with the stationary plates. Further there was no mention in the specification of the function recited in the above phrase. The applicant relied merely on Figure 2 of his drawing. Citing Technicon Instruments Corp. v. Coleman Instruments, 255 F.Supp. 630 (N.D. IL 1966), the court stated:

> "by disclosing in a patent application a device that inherently performs a function, operates according to a theory or has an advantage, the patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function theory or advantage without introducing prohibitive new matter." Id. At 98.

Thus, the case law is absolutely clear. Applicant is entitled to insert the disputed claim limitation. One skilled in the art would clearly appreciate from reading the application that the structure so claimed is the same structure disclosed. For that reason, Applicant would request the Examiner withdraw the rejections under 35 USC § 112.

Once that is done, those claim limitations must be given effect, and thus the rejection under 35 USC § 102(e) should be withdrawn for the reasons previously discussed. Further modification of Meyerhoff is in no way suggested by any other prior art or by the Meyerhoff reference itself. Applicant is accomplishing a totally different function with its structure relative to the structure disclosed in Meyerhoff, and thus the rejection under 35 § 103 is likewise inappropriate.

In light of this, Applicant would request reconsideration and allowance of the pending claims.

Respectfully submitted,

WOOD, HERRON & EVANS

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